



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,969	03/17/2004	Akio Ishida	2271/71534	4183
7590 Ivan S. Kavrukov, Esq. Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036				
EXAMINER				
PARK, CHAN S				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
09/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,969

Applicant(s)

ISHIDA, AKIO

Examiner

CHAN S. PARK

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9-17, 19-21, 23, 25-31, 33-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8, 18, 22, 24, 32, 36 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-17, 19-21, 23, 25-31, 33-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 3, 8, 18, 22, 24, 32, 36 and 38 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II. Election was made **without** traverse in the reply filed on 6/2/08.

Drawings

2. **Figure 1** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "performing the step of passing configuration information of the printer when a logical printer is auto-created by the function" (Claims 5, 10, 19 and 33) must be shown or the feature(s) canceled from the claim(s). The claims appear to indicate that the step of passing information is performed when the logical printer is created, that is, at the end of the auto-creation.

However, fig. 6 of the Drawings describes that the step of passing is performed during the auto-creation process. No new matter should be entered.

Furthermore, "the server including a function for constituting an environment in which applications run only in the server" must be shown. It is unclear from the Drawings and Specification what it means by an environment in which applications run only in the server. For example, how is this server different from the server described in the prior art of Fig. 1? Is the same type of server applied in the current invention?

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims are objected to because of the following informalities:

Claim 2, line 7, "information file" should be -- information ~~file~~ --;

Claim 20, line 12, "printer drover" should be -- printer driver --; and

Claim 34, line 13, "printer drover" should be -- printer driver --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 11-17, 19-21 and 23** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11-24 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 11-17, 19-21 and 23, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A

computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 10, 11, 19, 25 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites limitations of "a computer program for causing a client to store configuration information of a printer as a file" and "obtaining program code means for obtaining configuration information of the printer from a setting information storing region in the client". It is unclear if the obtaining program code means obtains the configuration information from the stored configuration information recited in lines 2-3. Are they referring to the same configuration information? If so, does it store the information in a file twice? Or is the "file" recited in line 3 referring to the setting information storing region? Clarification/explanation from the Specification is respectfully requested.

With respect to claim 11, arguments analogous to those presented for claim 25, are applicable.

Claim 5 recites the limitation of performing the step of passing configuration information of the printer when a logical printer is auto-created by the function.

Paragraph [0007] of the Specification states that "to create a logical printer is to make setting for the printer driver stored in the server 1 such that the printer driver can be used by the client 2". The statement appears to indicate that the information must be received by the printer driver in order to create the logical printer. If the settings of the printer driver are already changed by the auto-creation of the logical printer, it is unclear as to why the step of passing configuration information of the printer to the printer driver is necessary. Can the logical printer ever be created before the information is passed to the printer driver? Clarification/explanation from the Specification is respectfully requested.

With respect to claims 10, 19 and 33, arguments analogous to those presented for claim 5, are applicable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4, 6, 7, 9, 11-17, 19-21, 23, 25-31, 34, 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Koga U.S. Patent No. 7,075,670.

With respect to claim 1, Koga teaches a method used for providing configuration information of a printer to a printer driver in a server (printer driver stored in RAM 306 of the print server 300 in col. 3, lines 3-6 wherein the server 300 is embedded in the internet web server 100, the print server 102 or server 115 in col. 5, lines 30-32) in an image printing system that includes a client, the printer and the server (system shown in fig. 1), comprising the steps of:

storing, in the server, configuration information of the printer (server receiving/storing the attribute setting file in col. 5, lines 16-20) obtained from a setting information storing region of the client (hard disk 300 or RAM 306 for storing the attribute setting file in col. 6, lines 35-37), wherein the stored configuration information is associated with the printer driver of the printer (the attribute setting file configuring the printer driver in col. 4, lines 18-21); and

passing the configuration information of the printer to the printer driver in the server (reading the attribute setting file by the printer driver for executing the print job in col. 5, lines 36-44).

With respect to claim 2, Koga teaches the method as claimed in claim 1, the step of storing comprising the steps of:

storing the configuration information of the printer in the server (server receiving/storing the attribute setting file in col. 5, lines 16-20); and

storing, in the server, correspondence information (identification number in col. 8, line 65 ~ col. 9, line 2) between the printer driver and the configuration information file of the printer (storing the list of attribute information with the corresponding printer in col. 8, lines 50-53 & fig. 9).

With respect to claim 4, Koga teaches the method as claimed in claim 2, the step of passing comprising the steps of:

referring to the correspondence information and searching for the configuration information corresponding to information sent from the client (acquiring the attribute setting file based on the inputted identification number in col. 9, lines 14-24).

With respect to claim 6, arguments analogous to those presented for claim 1, are applicable.

With respect to claim 7, arguments analogous to those presented for claim 2, are applicable.

With respect to claim 9, arguments analogous to those presented for claim 3, are applicable.

With respect to claim 25, Koga discloses a computer readable medium storing a computer program for causing a client to store configuration information of a printer as a file (col. 8, lines 40-53), wherein the client is used in an image printing system that includes the client, the printer and a server including a printer driver of the printer (fig. 2), the computer program comprising:

obtaining program code means for obtaining configuration information of the printer from a setting information storing region in the client (setting attribute items in col. 4, lines 29-37); and

storing program code means for storing the obtained configuration information in a file (col. 4, lines 38-41 & col. 8, lines 5-13).

With respect to claim 26, Koga discloses the computer readable medium as claimed in claim 25, wherein the configuration information of the printer is information stored in the setting information storing region by a printer driver in the client (col. 4, lines 4-11 & col. 8, lines 5-13).

With respect to claim 27, Koga discloses the computer readable medium as claimed in claim 26, wherein the obtaining program code means obtains print setting information in addition to the configuration information, and the storing program code means stores the configuration information and the print setting information (setting print document items in col. 4, lines 24-28).

With respect to claim 28, Koga discloses the computer readable medium as claimed in claim 26, the computer program further comprising program code means for making the obtaining program code means to start to obtain the configuration

information right after the configuration information is stored in the setting information region by the printer driver in the client (col. 4, lines 4-11).

With respect to claim 29, Koga discloses the computer readable medium as claimed in claim 25, the computer program further comprising program code means for displaying a user interface screen by which a printer driver name can be specified;

wherein the obtaining program code means obtains configuration information of the printer corresponding to the printer driver name input from the user interface screen (fig. 9).

With respect to claim 30, Koga discloses a computer readable medium storing computer program for causing a server to provide configuration information of a printer to a printer driver of the printer in the sever (col. 8, lines 40-53), wherein the server is used in an image printing system that includes a client, the printer and the server (fig. 2), the computer program comprising;

program code means for referring to correspondence information used for searching for the configuration information of the printer, and passing the configuration information of the printer to the printer driver in the server (acquiring the attribute setting file based on the inputted identification number in col. 9, lines 14-24).

With respect to claim 31, Koga discloses the computer readable medium as claimed in claim 30, wherein the correspondence information (identification number in col. 8, line 65 ~ col. 9, line 2) is correspondence information between the printer driver and the configuration information of the printer (storing the list of attribute information with the corresponding printer in col. 8, lines 50-53 & fig. 9).

With respect to claim 34, Koga discloses a computer readable medium storing a computer program for causing a computer to store configuration information of a printer into a server (col. 8, lines 40-53), wherein the server is used in an image printing system that includes a client, the printer and the server (fig. 1), and the server includes a printer driver of the printer, the computer program comprising:

program code means for reading the configuration information of the printer (col. 8, lines 40-53),

program code means for storing the configuration information in the server (col. 8, lines 40-53);

program code means for creating correspondence information (identification number in col. 8, line 65 ~ col. 9, line 2) between the printer driver and the configuration information, and storing the correspondence information in the server (storing the list of attribute information with the corresponding printer in col. 8, lines 50-53 & fig. 9).

With respect to claim 35, Koga discloses the computer readable medium as claimed in claim 34, wherein the configuration information is a file created from information read from a setting information storing region in the client (col. 8, lines 5-13).

With respect to claim 37, Koga discloses the computer readable medium as claimed in claim 35, the computer program further comprising: program code means for displaying a user interface screen used for specifying the file, wherein the program code means for storing the configuration information stores the file specified from the user interface screen as the configuration information in the server (fig. 9).

With respect to claims 11-15, arguments analogous to those presented for claims 25-29, are applicable.

With respect to claims 16 and 17, arguments analogous to those presented for claims 30 and 31, are applicable.

With respect to claims 20, 21 and 23, arguments analogous to those presented for claims 34, 35 and 37, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koga as applied to claim 1 above, and further in view of the admitted Prior Art cited in the Background of Invention (hereinafter the Prior Art).

With respect to claim 5, Koga teaches the method as claimed in claim 1, but it does not disclose the server including a function for constituting an environment in which applications run only in the server and the step of passing configuration information of the printer when a logical printer is auto-created by the function when the client logs onto the server.

The Prior Art teaches the server including a function for constituting an environment in which applications run only in the server and the step of passing

configuration information of the printer when a logical printer is auto-created by the function when the client logs onto the server (paragraphs 0005~0008 in the corresponding Pub. US2004/0249936).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Koga to include the logging-in function as taught by the Prior Art.

The suggestion/motivation for doing so would have been to provide a secure printing environment by the logging-in function.

Therefore, it would have been obvious to combine Koga with the Prior Art to obtain the invention as specified in claim 5.

With respect to claims 10, 19 and 33, arguments analogous to those presented for claim 5, are applicable.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

September 2, 2008